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RECORD OF ORAL HEARING
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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAGMARA ORTMANN, KLAUSE-DIETHER WIESE,
OLIVER MOLLER and DIRK FRIDAG

Appeal 2009-007994
Application 10/584,148
Group Art Unit 1600

Oral Hearing Held: February 2, 2010

Before TONI R. SCHEINER, DONALD E. ADAMS, and LORA M. GREEN, *Administrative Patent Judges*.

ON BEHALF OF THE APPELLANTS:

HARRIS A. PITLICK, ESQ.
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1 *The above-entitled matter came on for hearing on Tuesday,*
2 *February 2, 2010, commencing at 10:37 a.m., at the U.S. Patent and*
3 *Trademark Office, 600 Dulany Street, 9th Floor, Alexandria, Virginia,*
4 *before Jan M. Jablonsky, Notary Public.*

5 THE CLERK: Good morning. Calendar number 9, appeal
6 number 2009-007994, Mr. Pitlick.

7 JUDGE SCHEINER: Thank you. Good morning.

8 MR. PITLICK: Good morning.

9 JUDGE SCHEINER: Whenever you are ready, you -- oh, I am
10 sorry. Do you have a business card for our reporter, please? Or, failing that,
11 if you just give him the spelling of your name and your firm -- thanks.

12 MR. PITLICK: Okay. What we have here is just one rejection
13 under section 103. In the Final Rejection, the Examiner has relied on two
14 additional references, and under the well-known footnote in re Hoch, we
15 considered these two references also as part of the rejection. However, the
16 Examiner's Answer -- I mentioned it also. I am assuming that the rejection
17 is simply *Gartrone and Martin* and -- or *Martin*.

18 The invention here is a process for preparing organophosphorus
19 compounds. It's a condensation reaction of a organophosphorus compound
20 having -- groups and a compound having hydroxyl groups. And the -- just
21 the invention -- the way it differs from the prior art is that this condensation
22 reaction is carried out in the presence of this one basic ion exchange resin.

23 Now, as we have indicated in the specification, in the
24 background, such reactions have been carried out with the addition of a base.
25 But that is problematical, in terms of things like reactions, you have to
26 remove byproducts, things of that sort. What is surprising in this case, that

1 basically these problems are substantially less with the use of the ion
2 exchange resin.

3 JUDGE ADAMS: If I may, can -- if I could focus you just a
4 little bit on the references, the Gatrone reference --

5 MR. PITLICK: Sorry, which one?

6 JUDGE ADAMS: The G reference, Gatrone?

7 MR. PITLICK: Yes.

8 JUDGE ADAMS: It speaks to the use of ion exchangers, but
9 that is post-synthesis, really --

10 MR. PITLICK: Yes.

11 JUDGE ADAMS: That is purification stuff.

12 MR. PITLICK: Yes.

13 JUDGE ADAMS: Is that right? So that reference alone does
14 not get us to incorporating an ion exchanger into the actual synthesis
15 reaction, as required by your claim, right? The condensation reaction.

16 MR. PITLICK: Yes, absolutely.

17 JUDGE ADAMS: Now, I'm struggling a little bit with Martins,
18 the Martin reference.

19 MR. PITLICK: Yes.

20 JUDGE ADAMS: It seems to me you say in your Brief, at least
21 in part, that you are somewhat agreeing with the concept -- this is at page
22 five of your Brief -- agreeing with this concept that the Examiner puts forth
23 that Martin discloses reacting a particular halogenated phosphorous
24 compound with hydroxyl compound in the presence of a basic ion exchange
25 resin.

26 MR. PITLICK: Well --

27 JUDGE ADAMS: Is that correct?

1 MR. PITLICK: Yes. But –
2 JUDGE ADAMS: Okay. Show me where in Martin that you
3 are referring to that. You say it is 7922 –
4 MR. PITLICK: Okay, on page 7922 -- first of all, as we
5 pointed out, the compounds in Martin have a phosphorous double-bond
6 oxygen point. So there is a difference right there.
7 JUDGE ADAMS: Right, right –
8 MR. PITLICK: But in –
9 JUDGE ADAMS: Let's just focus on where this ion exchanger
10 is.
11 MR. PITLICK: Yes. In scheme one.
12 JUDGE ADAMS: Yes.
13 MR. PITLICK: He's got pyridine water, then Amberlite.
14 JUDGE ADAMS: That would be that little italic "B," and the
15 arrow going across --
16 MR. PITLICK: Right.
17 JUDGE ADAMS: -- right?
18 MR. PITLICK: Right. And the –
19 JUDGE ADAMS: What is he using that for?
20 MR. PITLICK: We don't know, and that's the thing. It's –
21 JUDGE ADAMS: Okay. It is not -- if you -- do you have that
22 reference in front of you?
23 MR. PITLICK: I do.
24 JUDGE ADAMS: Okay. Underneath scheme one there, the
25 legend to scheme on that first paragraph there, follow it down about four
26 lines, and you will see that he is talking about the reaction of the group two

1 that he has in his scheme, and group three. And he reacts -- in quinoline and
2 acetonitrile, it's zero degrees for five hours, right?

3 MR. PITLICK: Yes.

4 JUDGE ADAMS: Followed by quenching with pyridine water
5 in the presence of IWT -- that is his ion exchange resin, right?

6 MR. PITLICK: That's right.

7 JUDGE ADAMS: Okay. So, can you tell me again what B is
8 doing in this reaction?

9 MR. PITLICK: I'm not sure what it's doing. But it's obviously
10 being used after the fact of the reaction.

11 JUDGE ADAMS: So is that a mistake, or you're just sort of
12 going along with the Examiner on page of your Brief there, where you said it
13 is involved in the reaction?

14 MR. PITLICK: Well, let me see what I said.

15 JUDGE ADAMS: Okay. First full paragraph, page five of the
16 Brief. Starts, "Martin does not remedy the above-discussed deficiencies."

17 (Pause.)

18 MR. PITLICK: Well, I mean, I said, "In the presence of a basic
19 ion." I suppose yes, based on the actual disclosure that he pointed out, it
20 appears that it is, again, being used after the fact, in terms of -- as you
21 quoted, there is a quenching going on with the pyridine and the --

22 JUDGE ADAMS: Now, in your mind, "quenching" means
23 stop, right?

24 MR. PITLICK: Yes.

25 JUDGE ADAMS: You stop the reaction by adding an ion
26 exchanger, is that right?

27 MR. PITLICK: That is how I would understand it, yes.

1 JUDGE ADAMS: So we have one reference, the G reference,
2 that talks about using an ion exchanger for purification after the fact. And
3 then we have the M reference, Martin, that talks about stopping a reaction
4 with an ion exchanger, right?

5 And the Examiner is using these two references to suggest an
6 ion -- the use of an ion exchanger in the presence of a condensation reaction,
7 right?

8 MR. PITLICK: Yes.

9 JUDGE ADAMS: Does that make sense?

10 MR. PITLICK: No.

11 JUDGE ADAMS: Okay. Now, this idea that you were going
12 after with the base, the Examiner is of the opinion that any base, any base
13 whatsoever, can be used in this reaction. I think that is where you were
14 heading us, down this path, when you started. Right?

15 But in this case, we have some art that talks about you are
16 actually quenching the reaction with the ion exchanger. Is that a basic
17 exchanger, as far as you know, that IWT TMD8? I do not know if it is, or
18 not.

19 MR. PITLICK: You know, I'm not sure. Because, in terms of
20 this reaction -- which, again, is dealing with different phosphorous
21 compounds -- I'm not sure exactly what's happening there.

22 JUDGE ADAMS: Okay.

23 MR. PITLICK: And I'm not here to testify on the chemistry. I
24 am sure you know it much better than I do. But you know, it's there in black
25 and white, as you point out, and they say "quenching."

26 So, there is two differences. There is -- not only is the
27 compound different, but it's not being used during the reaction in order to, in

1 effect, absorb, neutralize, et cetera, what a basic ion exchange resin would
2 do.

3 JUDGE ADAMS: Now, this –

4 MR. PITLICK: -- is generated.

5 JUDGE ADAMS: Now, again, this idea of any base would
6 work, what was your argument in response to any base -- so the Examiner --
7 if I am recalling the Examiner's rejection or arguments correctly, any base
8 would work. So, therefore, you put in an ion exchanger to suck up the
9 extraneous ions in the reaction.

10 MR. PITLICK: Well, I guess our response was they have used
11 bases -- for example, amines, things of that sort, and it doesn't work. I mean
12 you still have this problem.

13 Whereas, with the basic ion exchange resin, preferably weaker
14 base, or weak base, you don't have the problem. So, basically -- based on
15 the result, the result is different. And while we didn't get into the
16 comparative data and the specification because certainly, in our opinion,
17 there is no case, but if you were to look at that data you will see -- and you
18 get different results, in terms of using a base, compared to basic ion
19 exchange resin.

20 So, they are not -- certainly in the art, they are not treated to be
21 equivalent, certainly not equivalent in the way we are using it, and during
22 the reaction, as opposed to later on, for purposes of neutralizing.

23 JUDGE ADAMS: So, it would not be acting like the pyridine
24 in the Gatrone reference, right? Gatrone, at -- what is it -- 1080, where he is
25 talking about the BIS 2N, he is talking about doing a reaction in the presence
26 of pyridine, right?

1 MR. PITLICK: I haven't -- I'm on page 1080, but I'm not sure
2 where you --

3 JUDGE ADAMS: It is the BIS 2N hexyloxyethyl --

4 MR. PITLICK: Twenty-eight?

5 JUDGE ADAMS: Yes, 28. Thank you.

6 MR. PITLICK: I think the pyridine is your typical amine. I
7 mean your typical amine that acts as a base. Right. And as I say, you know,
8 in the background of the invention, we indicate that that's traditional, they
9 use an amine, which is a base, during such a reaction.

10 I mean, basically, what Gatrone says is it's no more than what
11 we have already -- this particular reaction is old, but for the basic ion
12 exchange resin.

13 JUDGE ADAMS: Okay. Did you want to add anything else?

14 MR. PITLICK: No. I think I -- I actually thank you for your
15 help.

16 JUDGE ADAMS: Well --

17 (Laughter.)

18 MR. PITLICK: You are quite frank. I hope -- at least it
19 seemed that way to me. But no, I --

20 JUDGE SCHEINER: Did you have anything to ask?

21 JUDGE GREEN: No.

22 JUDGE ADAMS: Okay, thank you.

23 Whereupon, at 10:49 a.m., the proceedings were concluded.

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